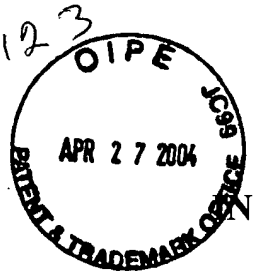
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Appellant:	§	*Group Art Unit*: 1711
ALLAN A. JAMES	§	
Serial. No.: 09/733,286	§	
Filed: December 8, 2000	§	
For: BLISTER-RESISTANT MOLDED POLYUREA POLYMER AND METHOD OF MAKING A BLISTER-RESISTANT MOLDED POLYUREA POLYMER	§	*Examiner*: R. Sergent
	§	*Attorney Docket No.*: 019131.03130

TRANSMITTAL

Enclosed for fiiing is:

1. Reply Brief (in triplicate) with Certificate of Mailing; and

2. Post card.

Respectfully submitted,

John Wilson Jones
Reg. No. 31,380
Locke Liddell & Sapp LLP
3400 Chase Tower, 600 Travis
Houston, Texas 77002-3095
(713) 226-1142
(713) 229-2570 (facsimile)

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REPLY BRIEF

John Wilson Jones
Registration No. 31,380
Locke Liddell & Sapp LLP
3400 Chase Tower
600 Travis
Houston, Texas 77002-3095
(713) 226-1142
(713) 229-2570 (FAX)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



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		§	*Attorney Docket No.*: 019131.03130

REPLY BRIEF

Honorable Commissioner of
Patents and Trademarks
Washington, DC 20231
Dear Sir:

Appellant hereby submits this Reply Brief, in triplicate.

ARGUMENTS

Claims 17, 18, 21-25 and 35 are method of use claims and thus are not anticipated by WO 96/22182 ("*Muenstermann*"). The Examiner states that the "instant situation is deemed to be fully analogous to a situation where the court has held that a process patent is anticipated by a reference that teaches a process that produces a product having the same properties, even though the prior art did not recognize that it possessed them or differs in a process parameter not set forth in the claims". The Examiner's position relies on *Verdegaal Bros. V. Union Oil of Calif.*,

(CAFC 1987) 814 F.2d 628, 2 USPQ2d 1051. The Court in *Verdegaal*, however, was presented with method of making claims, not method of use claims.

The claims in the patent-in-suit in *Verdegaal* were directed to a method for making a concentrated liquid fertilizer by reacting sulfuric acid and urea "by providing a non-reactive, nutritive heat sink, capable of dissipating the heat of urea and sulfuric acid." The issue in *Verdegaal* was whether a "heel" of liquid disclosed in the prior art (to *Stoller*) was a "non-reactive nutritive heat sink." The Court concluded in the affirmative based, in part, on the testimony of the expert witness of the patentee ("Verdegaal's own expert, Dr. Bahme, admitted that Stoller discussed the problem of high temperature caused by the exothermic reaction, and that the heel could function as a heat sink", *Verdegaal*, at 1054).

Verdegaal does not stand for the proposition advanced by the Examiner. Not only is the Examiner's position incorrect, it, in effect, vitiates 35 U.S.C. § 101 which protects method of use claims. *See Catalina Marketing International, Inc. v. Coolsavings.com, Inc.*, 62 USPQ2d 1781, 1786 (Fed. Cir. 2002) (a new use of a composition is properly claimed as a "method of use," in accordance with 35 U.S.C. 101).

While *Muenstermann* discloses the use of jojoba oil for use in an internal release composition, it clearly does not disclose a method of improving a molded polyurea's blister resistance by use of jojoba oil. *Muenstermann* does not disclose the concept of blistering, much less a means for reducing blistering. Since all of the elements of method of use claims 17, 18, 21-25 and 35 are not met by *Muenstermann*, the grounds of rejection under 35 U.S.C. § 102(b) over *Muenstermann* should be reversed.

The Examiner further continues to fail to address the issues relating to his rejection of the claims over *Muenstermann* and *Barron*. Claims 19 and 33-34 are also method of use claims.

The Examiner concludes that it would have been obvious to incorporate the polyepoxide of *Barron* into *Muenstermann*. However, as stated *supra*, *Muenstermann* does not disclose the use of jojoba oil to decrease blistering, much less to decrease blistering for an automobile body part. Neither does *Barron* cure such deficiencies.

Claims 36-45 are directed to a blister-resistant molded automobile body part and a process of making a blister-resistant molded automobile body part. The Examiner continues to argue prima facie obviousness but yet fails to address that *Muenstermann* does not disclose an automobile body part or a composition capable of exhibiting blister resistance. While Appellant agrees with the Examiner that both references are directed to polyureas, this by itself is an insufficient basis to conclude the existence of motivation to combine the cited references. The Examiner continues to fail to appreciate the different problems presented by the two references. In doing so, he fails to answer the query as to why one would want to go outside *Barron* and look to *Muenstermann* for assistance or vice versa?

Assuming arguendo that motivation exists to combine the cited references (which it does not), the Examiner's rejection still must fail because the teachings of the references do not indicate a reasonable expectation of success. The proper standard for testing obviousness is set forth in *In re Vaeck*, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991):

> Where claimed subjected matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under § 103 requires, inter alia, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success **Both the suggestion and the reasonable expectation of success must be founded in the prior art**, not in the applicant's disclosure. (Emphasis added.)

Barron states that blistering results when "moisture absorbed into a polyurea part interacts with the polymer to produce gas which accumulates in the part forming a gas pocket." (*Barron*, ll. 39-41, col. 1.) Like water, jojoba oil is a liquid and is thus volatile. There would be no reason to conclude, based on the teachings of *Barron*, that the addition of another volatile species, i.e., jojoba oil, to the polyurea would improve the blister resistance of molded polyurea.

In any event, the Examiner's combination of *Muenstermann* and *Barron* does not render the claims of Appellant prima facie obvious in light of the showing of unexpected results, specifically acknowledged by the Examiner. Note that the Examiner acknowledges (in paragraph 5 of the Examiner's Answer) the unexpected results obtained by the addition of jojoba oil to polyurea; such unexpected results are discussed in the Appellant Brief under the heading "Summary of Invention."

In summary, the Examiner's rejection over the combination of *Muenstermann* and *Barron* must be reversed because (i.) there is no motivation to combine the references; (ii.) there is no reason to conclude a reasonable expectation of success by combining the references; and (iii.) the unexpected results, acknowledged by the Examiner, rebut the prima facie case of obviousness.

Respectfully submitted,

Date: 04/22/04

JOHN WILSON JONES
Registration No. 31,380

Locke Liddell & Sapp LLP
3400 JP Morgan Chase Tower
600 Travis Street
Houston, Texas 77002-3095
(713) 226-1142, Telephone Direct
(713) 229-2570, Fax

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on April 22, 2004.

GLORIA BARBOZA